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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/690,941	10/21/2003	Roland J. Christensen	22149	7699
7590		10/04/2004	EXAMINER	
Garron M. Hobson THORPE NORTH & WESTERN, LLP P.O. Box 1219 Sandy, UT 84091-1219			SNOW, BRUCE EDWARD	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,941

Applicant(s)

CHRISTENSEN, ROLAND J.

Examiner

Bruce E Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/24/04; 10/21/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21 and 23-25, drawn to an ankle device classified in class 623, subclass 47.
- II. Claim 22, drawn to a method of adjusting an ankle, classified in class 623, subclass 53.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product. The body of the claimed process does not positively claim an adjustable ankle element, the process merely describes the walking motion of all non rigidly fixed ankle/foot devices. The product as claimed can be used in a materially different process of using wherein the adjustment element is fixed and the device is used to replace a missing foot/ankle for walking.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1 – figure 1

Species 2 – figure 7

Species 3 – figure 9

Species 4 – figure 10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 8, 16, 23, 25 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Garron Hobson on 9/28/04 a provisional election was made without traverse to prosecute the invention of Group 1 and species 1, claims 1-24 and 23-25. Affirmation of this election must be made by applicant in replying to this Office action. Claim 22 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, "foot member with the actuate projection extending from the foot member" is not understood and does not have antecedent basis.

Claim 7, "displacement member" lacks antecedent basis.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant claims give the identical element multiple names such as "displacement member" of claim 7 believed to be the same element named "projection" in claim 15. MPEP 608.01(o) states the *"use of a confusing variety of terms for the same thing should not be permitted"*. This is an example only, it is applicant's duty to assure all claim language is supported in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-21 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Slemker et al (6,228,124).

Slemker et al teaches an adjustable ankle device for a prosthetic foot comprising:

- a) an upper portion 32 configured to be coupled to a socket of an amputee; and
- b) a lower portion 22, adjustably coupled to the upper portion, configured to be attached to a foot member with heel and toe sections; and

- c) a movable coupling including elements 30, 28, 42, 44, disposed between the upper and lower portions, and fully capable of movable so that the lower portion moves:

- i) simultaneously in a downward and forward direction in which the lower portion simultaneously pivots downward and displaces forward with respect to the upper portion; and
- ii) simultaneously in a rearward and upward direction in which the lower portion simultaneously pivots upward and displaces rearward with respect to the upper portion; and
- d) the lower portion being pivotal and displaceable with respect to the upper

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portion between at least two fixed positions, including:

- i) a low position configured to dispose the heel section at a lower elevational position, and to dispose the heel section in a rearward position', and
- ii) a high position configured to dispose the heel section at a higher elevational position, and to dispose the heel section in a forward position.

Regarding at least claim 2, displacement member slidably coupled to a displacement track, see elements 42, 44.

Regarding at least claim 3, see arched coupling 28 and element 32 is the track.

Regarding at least claim 4, attachment member, see the interior of element 32 which receives element 12.

Regarding at least claim 5, "T-shape", see figure 5.

Regarding at least claim 7, see elements 40 and 36.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kramer et al (5,746,774).

Referring to figure 3, Kramer et al teaches an adjustable ankle device for a prosthetic foot comprising:

- a) an upper portion 43 configured to be coupled to a socket of an amputee; and
- b) a lower portion 45, adjustably coupled to the upper portion, configured to be attached to a foot member with heel and toe sections; and

c) a movable coupling including elements 46, 47 disposed between the upper and lower portions, and fully capable of movable so that the lower portion moves:

- i) simultaneously in a downward and forward direction in which the lower portion simultaneously pivots downward and displaces forward with respect to the upper portion; and
- ii) simultaneously in a rearward and upward direction in which the lower portion simultaneously pivots upward and displaces rearward with respect to the upper portion; and

d) the lower portion being pivotal and displaceable with respect to the upper portion between at least two fixed positions, including:

- i) a low position configured to dispose the heel section at a lower elevational position, and to dispose the heel section in a rearward position', and
- ii) a high position configured to dispose the heel section at a higher elevational position, and to dispose the heel section in a forward position.

Note the device is being described upside down from that being shown in the figures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BRUCE SNOW
PRIMARY EXAMINER